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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/553,862	10/21/2005	Koji Tsuchida	3273-0215PUS1	6571

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EXAMINER
DICUS, TAMRA

ART UNIT	PAPER NUMBER
1794	

NOTIFICATION DATE	DELIVERY MODE
04/04/2008	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

Office Action Summary	Application No.	Applicant(s)	
	10/553,862	TSUCHIDA ET AL.	
	Examiner	Art Unit	
	TAMRA L. DICUS	1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-8* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-8* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *01-23-06, 10-21-05*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claims 1-6 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over USPN US 5,186,782 to Freedman.

Freedman teaches a multilayer label having a core surrounded by skin layers, where the when an opaque film layer is required, calcium carbonate, titanium dioxide, and blends are used in the core and skin layers (5:20-68) along with resins such as EVA, polyethylene or polystyrene (2:10-50, 6:5-20, same material as Applicant, see Ex. 18 and performs the same stretching under heat with extrudates (6:55-68, 7:1-68) as in Applicant's Ex. 1 (pg. 27, lines 10-15) where the film is stretched in a lengthwise direction to yield a heat shrinkable film and thus the film of

Freedman is considered to function as heat-shrinkable) that are adhered to plastic bottles or other flexible articles (4:50-55, embraces container).

Freedman does not expressly teach the recited properties of transparency, transmission or W-value, however, because the same colors and materials are employed, the resultant properties are presumed inherently present.

Alternatively, if not inherent, then it would have been obvious to one having ordinary skill in the art to have modified the amount of colors to produce the desired properties because Freedman teaches the colors produce opaque films, and thus effects the opacity of the label as cited above.

Further to claim 6, how the film is prepared is represents process limitations in a product claim. Product-by-process claims are not limited to the manipulations of the recited steps, only the structure implied by the steps. Patentability of an article depends on the article itself and not the method used to produce it (see MPEP 2113). Furthermore, the invention defined by a product-by-process invention is a product NOT a process. *In re Bridgeford*, 357 F. 2d 679. It is the patentability of the product claimed and NOT of the recited process steps which must be established. *In re Brown,* 459 F. 29 531. Both Applicant's and prior art reference's product appear to be chemically and structurally the same.

4. Claims 1-8 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over USPN 7,306,844 to Chu et al.

Applicant cannot rely upon the foreign priority papers to overcome this rejection because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15.

Chu teaches a multilayered label affixed to containers (1:15-25, 7:35-40) where one or more layers of a multilayer film being tinted or opaque are blended with one or more pigments added to achieve the desired color, being white, black or grey (embraces chromatic color 3:1-15, 5:25-35, Examples 1-2), the film is printed with one or more print layers included messages or pictorial designs (6:14-68). The layers are comprised of polystyrene, same material as Applicant (see Ex. 18 and performs the same stretching under heat with extrudates (5:48-68) as in Applicant's Ex. 1 (pg. 27, lines 10-15) where the film is stretched in a lengthwise direction to yield a heat shrinkable film and thus the film of Freedman is considered to function as heat-shrinkable). At least three layer films are also exemplified (see Examples 11-12, thus embracing front, back, and core layers). Example 2 uses Red, Yellow and blue color pigments (claim 2). Claims 1-8 are addressed.

Chu does not expressly teach the recited properties of transparency, transmission or W-value, however, because the same colors and materials are employed, the resultant properties are inherently present.

Alternatively, if not inherent, then it would have been obvious to one having ordinary skill in the art to have modified the amount of colors to produce the desired properties because Chu teaches that carbon black results in a black or grey film (3:5-10) and depending upon the end use, the styrenic polymer film may be tinted or opaque and the pigments for these uses are well known in the art (3:1-11).

Further to claim 6, how the film is prepared are process limitations in a product claim. Product-by-process claims are not limited to the manipulations of the recited steps, only the structure implied by the steps. Patentability of an article depends on the article itself and not the method used to produce it (see MPEP 2113). Furthermore, the invention defined by a product-by-process invention is a product NOT a process. *In re Bridgeford*, 357 F. 2d 679. It is the patentability of the product claimed and NOT of the recited process steps which must be established. *In re Brown,* 459 F. 29 531. Both Applicant's and prior art reference's product are the same.

5. Claims 1-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 7,306,844 to Chu et al. in view of US 6,749,936 to Argoitia et al.

Chu essentially teaches the claimed invention above.

Chu does not teach using achromatic colors or the transparency, transmission or W-value properties per instant claims 1 and 4.

Argoitia teaches achromatic multilayer pigments used in ink, paint, or moldable plastic material with resins such as styrenes (21:1-30) and combined with pigments (chromatic) TiO_2 to produce unique color effects and with carbon black, blue or aluminum to control lightness and other color properties used as inks on packaging, containers, or used to form colored plastic materials, and extruded parts (21:50-68, 22:1-24).

It would have been obvious to one having ordinary skill in the art to have modified the article of Chu to include achromatic or chromatic color because Argoitia teaches advantages such as unique color effects and lightness control used in packaging or containers as cited above.

6. Claims 1-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 5,186,782 to Freedman in view of US 6,749,936 to Argoitia et al.

Freedman essentially teaches the invention above.

Freedman does not teach using achromatic colors or the transparency, transmission or W-value properties per instant claims 1 and 4 or an ink layer (per claim 7), while teaching applications to bottle containers (claim 8).

Argoitia teaches achromatic multilayer pigments used in ink, paint, or moldable plastic material with resins such as styrenes (21:1-30) and combined with pigments (chromatic) TiO2 to produce unique color effects and with carbon black, blue or aluminum to control lightness and other color properties used as inks for printing on packaging, containers, or used to form colored plastic materials, extruded parts and laminating films (21:50-68, 22:1-36).

It would have been obvious to one having ordinary skill in the art to have modified the article of Freedman to include achromatic or chromatic color in any layer and printed with ink because Argoitia teaches advantages such as unique color effects lightness control, and making an article decorative used in packaging or containers as cited above.

Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to TAMRA L. DICUS whose telephone number is (571)272-1519. The examiner can normally be reached on Monday-Friday, 7:00-4:30 p.m., alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Tamra L. Dicus /TLD/
Examiner
Art Unit 1794

03/26/08

/Terrel Morris/
Supervisory Patent Examiner
Group Art Unit 1794